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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,200

11/20/2003

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EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,200	Applicant(s) DEHLIN ET AL.	
	Examiner J. Gregory Pickett	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9 and 11-13 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☒ Claim(s) 14-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's submission filed on 28 November 2007 has been entered. Claims 1 and 4-17 are pending in the application. Claims 14-17 are withdrawn from further consideration as being directed to a non-elected invention. Claims 2 and 3 have been canceled.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Oath/Declaration

2. The Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to 01 June 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56. Applicants are advised that, notwithstanding the preceding waiver, an applicant who has not disclosed information that is material to patentability as defined in 37 CFR 1.56, because it was believed that the information was not "material to the examination," should disclose such information in order to discharge the applicant's duty of disclosure as required by 37 CFR 1.56, and should file a supplemental oath or declaration acknowledging that duty of disclosure.

Claim Rejections - 35 USC §§ 102 and 103

3. Claims 1, 4, 5, 7, 9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jones et al (US 6,752,272 B2; hereinafter Jones).

Claim 1 is a product-by-process claim (see MPEP 2113). Jones discloses a child-resistant carton package comprising an outer sleeve **1**, an insert **3** carrying a packaged product, and a locking mechanism **13/24/25** or **10**. Jones anticipates a fiber-based board (paperboard) reinforced with a polymer to increase resistance to tearing (see Col. 4, lines 10-14 and Col. 6, lines 9-13). Jones anticipates an extrusion-laminated, and therefore coated, board (Col. 6, lines 23-25) which bonds the polymer directly to the fiber-based material. Jones anticipates polyester (see Col. 6, lines 16-19).

Claim 4: Jones anticipates polyesters (see Col. 6, lines 16-19), of which PET is a subset.

Claim 5: Jones anticipates coating on both sides (Col. 6, line 11).

Claim 7: Jones anticipates the coating on both the sleeve and the insert (Col. 4, lines 10-14).

Claim 9: The laminate of Jones is delaminable.

Claim 11: Jones discloses a hole when item **13** is depressed.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claim 1 above, and further in view of Holbert et al (US 2003/0148110 A1; hereinafter Holbert).

Jones discloses the claimed invention except for the inner reinforcement layer. Holbert discloses a paperboard/polymer laminate with an inner reinforcement layer **14**, which may be polyester (see paragraph [0021]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the board of Jones with an inner reinforcement layer as taught by Holbert in order to improve tear resistance (see Holbert paragraph [0010]).

5. Claims 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, as applied to claim 1 above, and further in view of Schwenk (US 3,654,842).

Jones discloses the claimed invention except for the polymer shield and heat-sealing with seam overlapping.

Schwenk discloses a polymer shield (Figure 5) and heat-sealing with seam overlapping (Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carton of Jones by heat-sealing as taught by Schwenk in order to form a more durable bond.

Allowable Subject Matter

6. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

8. Applicant's arguments filed 23 August 2007 have been fully considered but they are not persuasive.

Applicant's continued assertion that Jones provides an adhesive layer remains unpersuasive. Extrusion lamination covers a substrate layer with an additional layer of material and therefore may be considered to "coat" the substrate layer. Applicant asserts that Jones produces more layers than disclosed; Jones itself certainly does not present this arrangement. For example, Jones states that HDPE is an acceptable material for laminating. As evidenced by Casey (US 5,091,261 at Col. 1, line 61 to Col. 2, line 1), HDPE may be directly applied to a paperboard layer without the need for an adhesive tie layer. Applicant's assertion that an adhesive tie layer must be present is without merit, particularly in view that Jones specifically recites "extrusion or adhesive lamination" (emphasis added) as alternative forms of connection.

Applicant mischaracterizes the examiner's position by attempting to state that there is some admission that Casey has a tie layer; this is completely contrary to the examiner's position. Casey (used in an evidentiary capacity), clearly presents a paperboard layer 11 and an extrudable, polyolefin layer 12 (HDPE) directly bonded to the paper layer 11 (Figure 1 and Col. 1 line 61 to Col. 2 line1). The adhesive layer is on

the opposite side of the polymeric layer and never touches the paperboard layer. The fact that Casey has an additional structure on an opposite side of the contacting layers does not detract from the fact that Casey is evidence of the ability to directly bond the polymer to the fiber-based board layer.

Applicant's arguments against teaching, suggestion, or motivation in Casey are not on point since no such rejection or combination is presented.

Applicant's extrusion coating results in a polymer layer on the fiber-based board (see applicant's specification at page 3, lines 30-34). The extrusion lamination (considered a coating) disclosed in Jones also produces a polymer layer on the fiber-based board. Accordingly, Jones produces the same product by means of a different process. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. (Same cite as above).

Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). The

arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/
Primary Examiner, Art Unit 3728